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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,604	06/27/2003	Kobi Richter	4396-4001	7611
27123	7590	05/01/2006		
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER CHATTOPADHYAY, URMI	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/607,604

Applicant(s)

RICHTER, KOBI

Examiner

Urmi Chattopadhyay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2006 and 07 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 4-30, 32-36 and 44-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 31, 37-43, 48 and 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Request for Continued Examination*

1. The request filed on April 7, 2006 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on Application No. 10/607,604 is acceptable and a RCE has been established. An action on the RCE follows.

### *Response to Amendment*

2. The amendment filed March 13, 2006 has been entered. The changes to the claims have been approved. Claims 1-49 are currently pending, of which claims 4-30, 32-36 and 44-47 remain withdrawn from consideration for being directed to a non-elected species. The claims being considered for further examination on the merits are claims 1-3, 31, 37-43, 48 and 49.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 31, 37-43, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shannon et al. (USPN 5,928,279) in view of Masumoto et al. (USPN 4,614,221).

Shannon et al. discloses an implantable medical device in the form of a stent with all the

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elements of claims 1, 31, 37 and 41, but is silent to the alloy being amorphous and having a metalloid. See Figure 2 and column 6, lines 13-18 for a stent (14) being formed of wires (18), wherein the wires (18) are made from a cobalt metal alloy. Masumoto et al. teaches using a cobalt or iron based alloy (Co-Si-B or Fe-Cr-P-B) to manufacture a thin metal wire according to a specific process in order for the wire to be of high quality, have a circular cross-section and an amorphous structure that has superior chemical, electromagnetic and physical properties. See column 3, lines 23-36 and 62-66, column 7, lines 3-8 and columns 7-8, lines 68-2. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the stent (14) of Shannon et al. by replacing the cobalt alloy wires (18) with the cobalt or iron based alloy (Co-Si-B or Fe-Cr-P-B) thin metal wires taught by Masumoto et al., which are of an amorphous alloy having a metalloid, in order for the wires to be of high quality, have circular cross-sections and an amorphous structure that has superior chemical, electromagnetic and physical properties. Claims 37 and 41 are product-by-process claims, and according to MPEP § 2113, these claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. The patentability of a product does not depend on its method of production, but on the product itself. Because Shannon et al., as modified by Masumoto et al., meet the structural limitations of claims 37 and 41 of a medical device containing a cobalt-based amorphous metal alloy having a metalloid, the claims are properly rejected thereby.

Claims 2 and 3, see Figure 2 for the medical implant being in the form of a stent (14), which is structurally capable of being permanently or temporarily implanted.

Claims 38-40 and 42-43 are product-by-process claims. They do not structurally further limit the claimed invention. See rejection to claims 37 and 41, supra.

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Claim 48, see rejection to claim 1, supra, for the amorphous metal alloy comprising boron.

Claim 49, see rejection to claim 1, supra, for the amorphous metal alloy being an iron based alloy, and wherein the iron-based alloy contains Fe, Cr, B and P.

### *Response to Arguments*

5. Applicant's arguments with respect to claims 1-3, 31, 37-43, 48 and 49 have been considered but are moot in view of the new ground(s) of rejection.

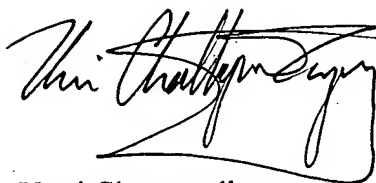
### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Masumoto et al. (USPN 4,473,401) discloses an amorphous iron-based alloy wire, which is formed by adding a specific amount of Cr and a specific amount of P or C to a Fe-Si-B type alloy in order to bring about notable improvement in amorphous texture forming ability and fatigue property. The further addition of Co, for example, improves electromagnetic property, thermal resistance, corrosionproofness, and mechanical property. See column 3, lines 33-48.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urmi Chattopadhyay whose telephone number is (571) 272-4748. The examiner can normally be reached Monday through Thursday and every other Friday from 9:00am to 6:30pm.

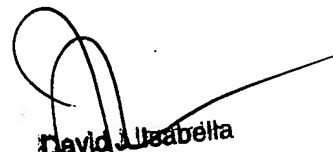
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached at (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Urmi Chattopadhyay

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David A. Usabell  
Primary Examiner